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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,216	08/27/2003	Steven S. Kan	MR1957-780	9648

4586 7590 10/11/2005

ROSENBERG, KLEIN & LEE  
3458 ELLICOTT CENTER DRIVE-SUITE 101  
ELLICOTT CITY, MD 21043

EXAMINER
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DUNHAM, JASON B

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 10/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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## Office Action Summary

Application No.

10/648,216

Applicant(s)

KAN, STEVEN S.

Examiner

Jason B. Dunham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☒ Claim(s) 9 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Objections*

Claim 9 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend upon 2 different dependent claims (claims 6 and 8). See MPEP § 608.01(n). Accordingly, the claim 9 has not been further treated on the merits.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-8, 10-22 and 24-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Berger (U.S. Patent No. 6,414,694).**

Referring to claim 1. Berger discloses a method for on-line outsourcing of customized merchandise containing personalized logo, wherein a remote customer in a network environment is connected to a server to customize a piece of tangible merchandise containing at least a personalized logo and the server outsource its production to a supplier; the method comprising the steps of:

- Providing a logo image database at the server end, wherein the database stores a plurality of constituent image parts of at least a default logo image and a

plurality of part elements showing characteristics of the constituent image parts  
(Berger: abstract);

- Providing a merchandise image database at the server end, wherein the database stores a plurality of constituent image parts of at least a default merchandise image and plurality of part element showing characteristics of the constituent image parts (Berger: abstract);
- Personalizing a preferred logo image, by the remote customer, by selecting at least an image part and at least a part element stored in the server's logo image database for the server's on-line generation of the remote customer's personalized logo image (Berger: abstract);
- Customizing a preferred merchandise image, the remote customer, by selecting at least an image part and at least a part element stored in the server's merchandise image database for the server's on-line generation of the remote customer's customized merchandise image (Berger: abstract);
- Generating, by the server, the customized merchandise image containing at least a personalized logo image by incorporating the personalized logo image with the customized merchandise image selected by the remote customer (Berger: abstract); and
- Transmitting by the server, the generated customized merchandise image containing at least a personalized logo image to a supplier for the production of at least a piece of tangible, customized merchandise according to the said

customized merchandise image containing at least a personalized logo image  
(Berger: abstract).

Referring to claim 2. Berger further discloses a method wherein the network environment involves at least one of the Internet, a local area network, a proprietary network and a wireless communication network (Berger: column 1, lines 5-10).

Referring to claim 3. Berger further discloses a method wherein said logo image consists of at least one of digitized alphabet, number, symbol, and picture presented in 2-D or 3-D manner (Berger: column 1, line 65- column 2, line 29).

Referring to claim 4. Berger further discloses a method wherein said logo means a business or non-profit entity's identity logo, trademark, server mark, or icon representing a product, a work, a service, a character, or an activity (Berger: column 1, line 65- column 2, line 29 & column 5, lines 5-26).

Referring to claim 5. Berger further discloses a method wherein each said part element of a logo image has a unique code (Berger: figure 2 & figure 3, step 326).

Referring to claim 6. Berger further discloses a method wherein said part elements are further grouped into a plurality of categories reflecting distinct attributes including at least one of shape, style, pattern, special effect, contour, color, material, size, and production technique (Berger: column 6, line 52- column 6, line 32 & figure 7).

Referring to claim 7. Berger further discloses a method wherein said merchandise image is digitized, 2-D or 3-D, image representing a piece of tangible merchandise (Berger: column 6, line 52- column 6, line 32 & figure 7).

Referring to claim 8. Berger further discloses a method wherein said part elements of merchandise images are further grouped into a plurality of categories reflecting distinct attributes including at least one of shape, style, pattern, special effect, contour, color, material, size, and production technique (Berger: column 6, line 52- column 6, line 32 & figure 7).

Referring to claim 10. Berger further discloses a method wherein each said part element of the merchandise image has a unique code (Berger: column 6, lines 3-19 & figure 6).

Referring to claim 11. Berger further discloses a method including a step of authorizing the remote customer's request for on-line logo personalization (Berger: figure 5).

Referring to claim 12. Berger further discloses a method wherein said personalized logo image has a unique identification code consisting of each logo part element's unique code (Berger: column 7, lines 57- column 8, line 19).

Referring to claim 13. Berger further discloses a method including a step of displaying, at the remote customer end, the personalized logo image generated by the server according to said remote customer's selection of at least an image part as well as at least a part element to assist said remote customer's confirmation of the logo personalization (Berger: column 7, lines 44-56 & figure 9).

Referring to claim 14-16. Claims 14-16 are rejected under the same rationale set forth above.

Referring to claim 17. Berger further discloses a method comprising the steps of:

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- Receiving, by the server, the remote customer's upload of an edited or self-designed part element for a logo image or a merchandise image (Berger: column 3, lines 30-58 & figure 1);
- Storing, by the server after approval, said edited or self-designed part element in the corresponding logo image or merchandise image database Berger: column 3, lines 30-58 & figure 1).

Referring to claim 18. Berger further discloses a method including a step of receiving the remote customer's indication of preferred locations and sizes of said personalized log image to be incorporated with the customized merchandise image (Berger: column 7, lines 32-56 & figure 8-9).

Referring to claim 19. Berger further discloses a method including a step of displaying, at the remote customer end, said customized merchandise image containing at least a personalized logo to assist said remote customer's confirmation of the preferred location and sizes (Berger: column 7, lines 44-56 & figure 9).

Referring to claim 20 Berger further discloses a method wherein said customized merchandise image containing at least a personalized logo image has a unique identification code set consisting of the unique identification codes of the constituent customized merchandise and personalized logo images (Berger: column 7, lines 57- column 8, line 19).

Referring to claim 21. Berger further discloses a method comprising the steps of:

- Providing an outsourcing database at the server end, wherein the database stores business information of at least a supplier and data of outsourcing invoice records (Berger: column 8, lines 1-19); and
- Providing a customization order database at the server end, wherein the database stores data of customization order records (Berger: column 8, lines 1-19).

Referring to claim 22. Berger further discloses a method including a step of receiving confirmation, from the remote customer, for the outsourcing of the production of said tangible, customized merchandise according to the said customized merchandise image containing at least a personalized logo image (Berger: column 8, lines 1-19).

Referring to claim 24. Berger further discloses a method wherein said supplier's business information at least include its business registration data, and wherein said outsourcing invoice record includes an outsourcing case number, the unique identification code set of the customized merchandise image containing at least a personalized logo image, and information of the unit price, the ordered quantity, the total amount, the name and address for delivery, and the deadline of delivery (Berger: column 8, lines 1-19 and figure 3, step 334).

Referring to claim 25. Berger further discloses a method wherein said customization order record comprises a customization order number, the outsourcing case number, the unique identification code set of the customized merchandise image containing at least a personalized logo image, and information of the unit price, the



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ordered quantity, the total amount, the name and address for delivery, and the deadline of delivery (Berger: column 8, lines 1-19 and figure 3, step 334).

Referring to claim 26. Claim 26 is rejected under the same rationale set forth above.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Berger (U.S. Patent No. 6,414,694) in view of Haynes (U.S. Patent Application Publication No. 2004/0098315).**

Referring to claim 23. Berger discloses a method of transmitting information of the preferred location and sizes of the logo image to be incorporated with the customized merchandise image to said supplier (Berger: column 8, lines 1-19). Berger does not expressly disclose a method of transmitting an invoice to a supplier. Hayes discloses a method comprising:

- Transmitting an outsourcing invoice to a remote supplier to bind the supplier's production of said tangible, customized merchandise containing at least a logo (Haynes: paragraph 81); and
- Transmitting to the remote customer a customization order, information of the preferred location and sizes of the logo image to be incorporated with the

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customized merchandise image, and said customized merchandise image containing at least a personalized logo image to bind the merchandise customization (Haynes: paragraph 81).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Berger in include sending invoices for customized merchandise, as taught by Haynes, in order complete the purchase of said customized merchandise.

### ***Conclusion***

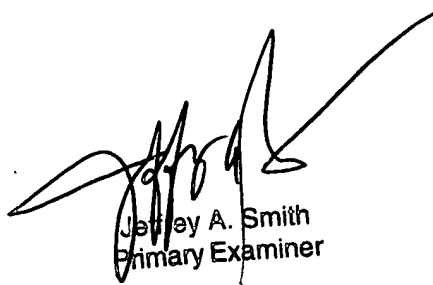
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason B. Dunham whose telephone number is 571-272-8109. The examiner can normally be reached on M-F, 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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JBD



Jeffrey A. Smith  
Primary Examiner